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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,307	03/16/2001	Robert K. Smith	T8-464854US	5399

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 04/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/809,307

Applicant(s)  
ROBERT K. SMITH

Examiner  
YVONNE M. HORTON

Art Unit  
3635



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 22, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8 & 12 6) ☐ Other:

Art Unit: 3635

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed 1/22/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The specification and the original claims require a “waterproof” material. However, the claims now require a “moisture impervious” sheet. “Moisture impervious” is not the same as “waterproof”. “Waterproof” is directed to water; however, “moisture” can be the result of any condensed liquid not specifically water. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no support in the specification for the lower member being a continuous sheet.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1,3,7,9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,572,842 to STIEF et al. STIEF et al. discloses the use of a flooring panel including a top rigid member (2), a lower moisture impervious continuous sheet (7) having a plurality of

Art Unit: 3635

knob projections (4) extending away from the upper sheet (2) and protecting the upper sheet (2) from moisture while inherently allowing free drainage of moisture about the projections (4), and at least one interlocking assembly (16). In reference to claim 3, the lower member (7) is plastic, column 2, line 17. Regarding claim 7, the upper member (2) is liquid fill and inherently is “adhesively” attached to the lower member (7). In reference to claims 9 and 10, the interlocking assembly (16) includes a tongue/key (17) and at least one groove (18).

5. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,572,842 to STIEF et al. STIEF et al. discloses the use of a flooring panel including a top rigid member (2), a lower moisture impervious continuous sheet (7) having a plurality of knob projections (4) extending away from the upper sheet (2) and protecting the upper sheet (2) from moisture while inherently allowing free drainage of moisture about the projections (4), and at least one interlocking assembly (16) including a tongue (17) and a groove (18).

6. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,572,842 to STIEF et al. STIEF et al. discloses the use of a flooring panel including a top rigid member (2), a lower moisture impervious continuous sheet (7) having a plurality of knob projections (4) extending away from the upper sheet (2) and protecting the upper sheet (2) from moisture while inherently allowing free drainage of moisture about the projections (4), and at least one interlocking assembly (16) including a tongue (17) and a groove (18).

Art Unit: 3635

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 2,5,6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,572,842 to STIEF et al. in view of WO 82/03099. STIEF et al. discloses the basic flooring system except for the top member being formed from waferboard material. WO 82/03099 teaches that it is known in the art to use a waferboard material (9) as the top member in a flooring system. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the top layer of STIEF et al. from a waferboard material, as taught by WO 82/03099. Regarding claim 5, the lower member (7) of STIEF et al. is plastic, column 2, line 17. In reference to claim 6, although STIEF et al. discloses the use of a plastics material, he does not specify what type of plastic material. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended as an obvious matter of design choice.

Regarding claim 8, it would have been obvious to one having ordinary skill in the art to use an adhesive to attach the upper waferboard of WO 82/03099 to the lower member of STIEF et al.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,572,842 to STIEF et al. STIEF et al. discloses the basic floor member except for specifically detailing if the lower member is polyethylene. STIEF et al. does; however, detail that his lower member is plastic. although STIEF et al. discloses the use of a plastics material, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a

Art Unit: 3635

known material on the basis of its suitability for the use intended as an obvious matter of design choice.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909.

YMH

April 7, 2003

A handwritten signature in black ink, appearing to be 'YMH' with a stylized flourish extending to the right.